



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

R-1986-1

February 14, 1986

In re the Examination of : DECISION ON PETITION  
: TO THE COMMISSIONER  
: UNDER 37 CFR § 10.2 (c)  
: TO REGISTER  
: THEODORE A. BREINER AS  
: REGISTERED PATENT ATTORNEY

The above identified petition is granted with respect to review of the final decision ("Decision") of the Director of the Office of Enrollment and Discipline ("Director") of the grading of examination for registration to practice before the Patent and Trademark Office under 37CFR \$10.2(c). The petition is denied with respect to registration.

A review of the regrading has not disclosed any areas in which additional points should be granted. On the contrary, the grader and regrader were generous in not deducting more points. A point should have been deducted for lack of antecedent for "tapered tip" which was apparently introduced to refer back to the "tapered tip member." The same can be said of the recitation of "tip" at the end of claim 1.

More points should probably have been deducted for failure to recite the pen and ink cartridge, lamp and battery as being located within the "tubular barrel." In the claim those elements are not located with respect to the barrel. They could be located outside. Neither is the end of the pen and ink cartridge recited to extend from the end of the barrel.

Petition argues at page 18 that Gomes has no means for retracting or extending the cartridge in Gomes. Petitioner's amended claim recites a means for retaining but fails to recite a

means for retracting or extending. On page 7, petitioner argues that his application "claims a combination flashlight and pen having a means for retaining the writing cartridge when the pen is not in use and for extending said cartridge when in use." That is not what the claim recites.

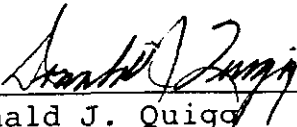
The first amendment to the claim recites "retaining"----in a retracted---or extended in a writing position. Without reciting placement and relations of parts, it is difficult to determine what the "position" relates to. The pen and ink cartridge, the lamp and battery could each be outside the "tubular barrel." There is no recited basis for the recitation" whereby when said lamp is energized" for there is no recited means for energizing the lamp.

Petitioner should test his claim by trying to draw the device defined by the amended claim, locating each part as specifically recited in the claim. In doing so, it will be apparent that the amendments to the claim did not give sufficient specificity to distinguish patentability over Gomes.

Probably as many as 9 additional points should have been deducted for failure to properly recite the parts and their relationship.

Note has been taken of petitioner's arguments with respect to Questions 2 and 3. There is no basis for changing the position spelled out in Mr. Cameron Weiffenbach's decision dated January 24, 1985.

The petition is GRANTED to the extent of reviewing the final decision but is DENIED with respect to registration.

  
\_\_\_\_\_  
Donald J. Quigg  
Assistant Secretary and  
Commissioner of Patents and Trademarks

2-14-86  
Date



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

R-1986-1(R)

February 28, 1986

In re the Examination of : DECISION ON REQUEST  
: FOR RECONSIDERATION  
: TO THE COMMISSIONER  
: TO REGISTER  
: AS  
: REGISTERED PATENT ATTORNEY

**DECISION ON RECONSIDERATION**

Petitioner, has requested Reconsideration  
of the Decision on Petition to the Commissioner under 37  
C.F.R. 10.2(c) to register as Registered  
Patent Attorney, dated February 14, 1986.

The Request for Reconsideration is granted to the extent  
that Petitioner wishes to have a specific discussion spelled  
out as to question Nos. 2. and 3. and to the extent of considering  
Respondent's answer to No. 4. The Decision on Petition  
dated February 14, 1986, was complete with respect to question  
No. 1 and Request for Reconsideration of that question is  
denied.

Question No. 2: Petitioner argues at great length that his  
answer with respect to question No. 2. was correct. As  
stated in the Decision on Petition dated February 14, 1986,  
there is no basis for changing the position spelled out in  
Mr. Weiffenbach's Decision dated January 24, 1985. Despite  
the prolix arguments made by Petitioner as to the correctness  
of his answer, it is still concluded that the Petitioner did  
not properly answer the question.

Petitioner argues that Gomes does not show the use of annular grooves in taper tip No. 9 of applicant's invention. He also argues that Gomes fails completely to disclose connector member 25 of applicant's invention also having annular grooves. He properly argues that Kenney disclosed lens for a right and left headlamp to provide illumination over a wide area.

The real question is whether or not there is a teaching for a combination of Gomes and Kenney. Obviously, Kenney teaches the use of grooves in order to direct rays of light in a given direction. The thing that is missing is a suggestion that Gomes would want to direct the rays of light to a certain point. The thing that Petitioner failed to point out was that Gomes does not provide a teaching of a need to focus light at a given point, but rather provides a teaching of diffusion of light to cover a fairly broad area. Petitioner needed to make that distinction so as to clearly show that there was no teaching for the combination. Instead, Petitioner simply argued that Gomes did not disclose the use of annular grooves. Such a statement does not rule out some teaching that Gomes may have made of an object to focus the rays of light in a given small area.

Petitioner argued that Gomes did not show the connector having grooved light directors. That argument has no real merit with respect to a question of the 103 rejection. The point was whether or not there was a light source, and what disposition was made of rays from the light source in the teaching of the reference. Gomes teaches diffusing the light and that would be determinative of the question.

As stated in the Decision on Petition to the Commissioner dated February 14, 1986, there is no basis for changing the position taken by Mr. Weiffenbach's Decision dated January 24, 1985, with respect to claim 2.

Question No. 3: Petitioner argues strenuously that the only requirement he had with respect to this question was to show a way in which to respond to the situation where new references were found. That argument is untenable. Several questions must be considered as possibilities when new references are found. 1. Would it be possible to swear behind the references with a 1.131 affidavit? That was not considered by Petitioner. 2. The possibility exists that the reference is old enough that it would not be possible to swear behind it. In such an event, it would be necessary to consider whether the claims would have to be amended in order to differentiate from the reference. Obviously, time being short, after receipt of form PTOL-327 consideration of the possibility of amendment of the claims and presentation of such amendment along with the Information Disclosure Statement should have been considered. Despite Petitioner's arguments to the contrary, the fact that he did not consider the Information Disclosure Statement content under 37 C.F.R. 1.98, leaves in doubt the question of whether or not Petitioner was cognizant of the necessary content of such a statement. Two requirements of that Disclosure are mandatorily set by 1.98. Although the remaining provisions of the Rule are not mandatory, Petitioner should have called attention to the requirements set by 1.98.

With respect to question No. 3, as stated in the Decision on Petition dated February 14, 1986, there is no basis for changing Decision spelled out in Mr. Weiffenbach's Decision dated January 24, 1985.

Question No. 4: A review of Petitioner's answer to Question No. 4. emphasizes the weakness that was displayed in connection with the amendment of the claim in Question No. 1. I would reject Petitioner's claim 4 under 35 U.S.C. 112, second paragraph. Petitioner's claim does not particularly point out and distinctly claim the subject matter which the applicant

regards as his invention.


As suggested in the Decision dated February 14, 1986, with respect to Question No. 1, Petitioner should learn to test his claims by trying to draw the device defined by his claim, locating each part in respect to its relation to the other remaining parts of the claim. Such a procedure would help him establish a unity of his device.

In sub-paragraphs A. and B. of claim No.4, Petitioner recited the first and second longitudinal legs, each having an end-plate at one end. The function of that plate and its purpose is not clear. If the purpose of the plate is to provide a means by which a headboard could be attached to the frame, it would be necessary to recite that the plates are on the same ends of each of the longitudinal legs. Petitioner does not indicate the relationship between the crossrails which are recited in sub-paragraph C of the claim. Sub-paragraph E of the claim provides that the first and second longitudinal legs and crossrails are held in their extended horizontal positions by clamp means. There is no indication that the crossrail attached to one end of a longitudinal leg has any relationship to the crossrail attached to a similar end of the other longitudinal leg.

It is not understood as to what is intended by the recitation in sub-paragraph F of the claim in the statement "Said crossrails and longitudinal rails each lying in a vertical plane." If this is a bed frame, those rails would normally lie in a horizontal plane. The claim is also obscure in sub-paragraph D in which flanged leg supports have caster assembly attached in vertical relation. Sub-paragraph G is also obscure in stating that the flanged leg members with caster assemblies are attached at the junction of the crossrails and longitudinal rails and lying in a horizontal plane. This portion of the

claim further is ambivalent in that there is no recitation as to whether it is the caster end or the other end of the legs that is attached to the crossrails. It is my opinion that there is a such a lack of clarity, conciseness, support in Exhibit D and completeness with respect to related parts that 20 points should have been deducted for this claim.

The Petition is Granted to the extent of reviewing questions 2, 3, and 4. It is DENIED with respect to Reconsideration of the Decision with respect to question 1. No change in the grading will be made. With regard to petitioner's request as to whether this Decision represents a final agency action, petitioner's attention is directed to 5 U.S.C.A. 704.

  
Donald J. Quigg

Assistant Secretary  
and Commissioner of Patents and Trademarks

2-28-86  
Date